

REMARKS

By this Amendment, Applicants have amended claims 1, 15, 29, 43, and 57. Support for the amendments can be found in the originally-filed specification at, for example, paragraphs [045], [063], [073], and [074]. No new matter has been added.

Summary

The final Office Action,¹ the Examiner objected to the specification; rejected claim 57 under 35 U.S.C. § 112, first paragraph; and rejected claims 1-61² under 35 U.S.C. § 103(a) as being unpatentable over Sansone et al. (US Patent No. 5,068,797, "Sansone") in view of Williams et al. (U.S. Patent Application Publication No. 2002/0032573, "Williams").

Objection to the Specification

Applicants respectfully traverse the objection to the specification. In objecting to the specification, the final Office Action states that "[t]he amendment filed 5 June 2008 is objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure." Final Office Action, p. 3. The final Office Action further states that "[c]laim 57 recites a limitation 'receiving a change in the assignment data file', which is not supported by the specification." *Id.*

First, Applicants do not agree with the final Office Action's allegation that the recitation of "receiving a change in the assignment data file" in claim 57, as presented in

¹ The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the final Office Action.

² The final Office Action states "claims 1-57" are rejected under 35 U.S.C. § 103(a) on p. 3. It appears to be a typographical error because claims 58-61 also appear to be rejected under 35 U.S.C. § 103(a), as shown in the context of the rejection at pp. 7-8. Applicants' response is based on this interpretation of the final Office Action.

the Amendment filed June 5, 2008, introduces new matter. Second, even assuming that the final Office Action's allegation regarding new matter were correct, the objection to the specification is still inappropriate because the Examiner alleges that new matter was only added to claim 57, and was not added to the specification. "If new matter is added only to a claim, an objection [to the specification] should not be made, but the claim should be rejected using form paragraph 7.31.01." See M.P.E.P. § 706.03(o), *Examiner Note*, No. 3. Therefore, the final Office Action should not have made the objection to the specification because the specification was not amended to add the alleged new matter. Applicants respectfully request withdrawal of the objection to the specification.

Rejection of Claim 57 under 35 U.S.C. § 112, First Paragraph

Applicants disagree with Examiner's allegation that the recitation of "receiving a change in the assignment data file" in claim 57, as presented in the Amendment filed June 5, 2008, introduces new matter. Nevertheless, to advance prosecution, Applicants have amended claim 57 to delete the above recitation. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 112, first paragraph, rejection of claim 57.

Rejection of claims 1-61 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over Sansone in view of Williams. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. See M.P.E.P. §

2144.08(II)(A), 8th Ed., Rev. 6 (September 2007). Furthermore, the Examiner must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. §§ 2143.03 and 2141(III).

Claim 1 recites a method of managing delivery carriers, the method including, among other things, the following features:

- determining, using the computer system, routes for delivery using the delivery data and a set of business rules;

- assigning, using the computer system, mail items to delivery carriers based on the determined routes;

- measuring the performance of the delivery carriers;

- transmitting, using the computer system, mail item assignment information to the mail processors;

- monitoring updated information relating to at least one of the routes for delivery and a capacity of the delivery carriers;
and

- dynamically reassigning the mail items to different delivery carriers based on the monitoring of the updated information.

Applicants submit that Sansone does not teach or suggest each and every feature of claim 1. Specifically, Sansone does not teach, as admitted on p. 4 of the final Office Action, “measuring the performance of the delivery carriers,” as recited in claim 1. Applicants submit that in addition to the nondisclosure of the claimed “measuring” step, Sansone also does not teach or suggest “monitoring updated information relating to at least one of the routes for delivery and a capacity of the delivery carriers; and dynamically reassigning the mail items to different delivery carriers based on the monitoring of the updated information,” as recited in amended claim 1.

Instead, Sansone discloses a data center interconnected with a plurality of batch mailers and the Postal Service. See Abstract. The data center generates data to the batch mailers for merging mail batches to achieve an additional postage discount, and to schedule and route mail carriers external to and within the Postal System to increase efficiency of handling. *Id.* The data center maintains a database of Postal Service facilities, resources available, and workloads, and thus provides as a service to the Postal Service information that enables the Postal Service to process arriving mails more efficiently. Col. 11, line 68 through col. 12, line 4.

However, there is no teaching or suggestion in Sansone regarding “monitoring updated information relating to at least one of the routes for delivery and a capacity of the delivery carriers; and dynamically reassigning the mail items to different delivery carriers based on the monitoring of the updated information” (emphasis added), as recited in amended claim 1. Therefore, Sansone does not teach or suggest at least the above-quoted features recited in amended claim 1.

Notwithstanding the final Office Action’s alleged teaching by Williams, which Applicants do not concede, Williams does not teach or suggest, among other things, at least the above-quoted “monitoring updated information . . . and dynamically reassigning the mail items to different delivery carriers . . . ,” as recited in amended claim 1. Therefore, Williams does not cure the deficiencies of Sansone.

For at least the foregoing reasons, Sansone and Williams, whether taken alone or in combination, fail to teach or suggest the recited features of amended claim 1, and the final Office Action incorrectly determined the scope and content of the prior art. Moreover, the undisclosed features represent significant differences between the

claimed invention and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references.

Dependent claims 2-14 and 58 are also allowable at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Although of different scope, each of amended independent claims 15, 29, 43, and 57 includes similar features as those recited in amended claim 1. For at least the same reasons claim 1 is allowable, each of independent claims 15, 29, 43, and 57 is also patentable over the cited references, and thus, is allowable. Dependent claims 16-28, 30-42, 44-56, and 59-61 are also allowable at least by virtue of their respective dependence from independent claims 15, 29, and 43, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-61.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response
and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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